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APR 06 2005

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re: Application of: Simon Erani Patent Application  
Serial No.: 09/922,233  
Filing Date: 8/3/2001  
For: Compositions and Methods  
for Skin Treatment  
Examiner: Theodore J. Criares  
Art Unit: 1617  
Attorney Docket No.: 4061.007

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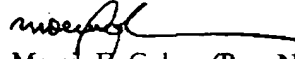
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**Transmittal Letter (5 pages including this cover page)**

Enclosed please a Response to the Office Action of October 6, 2004, including a request for a three month extension of time. The Commissioner is authorized to charge Deposit Account No. 50-1604 for all fees required, and it is requested that any overpayments be credited thereto.

Dated: April 6, 2005

Respectfully submitted,

  
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**CERTIFICATE OF MAILING (FACSIMILE TRANSMISSION)**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Technology Center 1600) at Facsimile Number 703-872-9306 on April 6, 2005.

  
Morris E. Cohen  
Transmission Date: April 6, 2005

Application of Simon Erani  
Serial No. 09/922,233 filed 8/3/2001  
Response of 4/6/2005 to Office Action of 10/6/2004

### Response to Office Action of October 4, 2004

Receipt is acknowledged of the Office Action of October 4, 2004 in the above-captioned matter. Reconsideration of the application and a three month extension of the time provided for response are respectfully requested. The Commissioner is hereby authorized to charge Deposit Account No. 50-1604 for all fees required, and it is requested that any overpayments be credited thereto.

In the Office Action, the Examiner allowed pending claims 2, 7, 20, 25, and 34-37. The remaining claims were rejected over Brooks II in view of French Reference 2,746,008 on the grounds that the present invention would be obvious under 35 U.S.C. §103 in view of the teachings of those references. Reconsideration of the rejections is respectfully requested.

With respect to the claims that were rejected, in response to counsel's arguments the Examiner has indicated that applicant is claiming a composition comprising compounds (a) through (e) and that the prior argument attacks the references individually. However, it is respectfully submitted that counsel's argument is not addressed to the references individually but to their combination.

With respect to claim 1, the fact that the claim is directed to the combination of all of the components (a) through (e) only further supports that the subject matter of the claim is patentable. Rejection of this claim requires a showing that it would be obvious to provide the particular combination of retinyl palmitate polypeptide and ascorbylmethylsilanol pectinate and tocopheryl polypeptide and cholecalciferol polypeptide and niacinamide polypeptide, all together. *See e.g.*, M.P.E.P. §2141.02 (Rev. 2 May 2004, p. 2100-124 - 2100-125) (under 35 U.S.C. 103 the question is whether the claimed invention as a whole would have been obvious). It is submitted that the combination of

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ascorbylmethylsilanol pectinate with any of the other components is non-obvious, much less a composition which combines it with all of the other ones.

Regarding this claim, the invention of claim 1 is not at all obvious – on the contrary, the art of record taken together and as a whole leads one away from this combination. While the French '008 reference appears to disclose a form of Vitamin C, the cited Brooks II reference itself provides a form of Vitamin C, which it calls VITAZYME™ C, and which it recommends.

In fact, Brooks II includes a large chart showing the stability of VITAZYME™ C in comparison to ascorbic acid and a substance referred to as VCPMG (which is believed to be another form of Vitamin C). One of ordinary skill in the art in possession of the combined references and looking for a form of Vitamin C to use with one of the VITAZYME™ compositions disclosed in Brooks II would naturally use the VITAZYME™ form of Vitamin C actually preferred and recommended by Brooks II. Brooks II leads away from applicant's choice to reject use of a polypeptide form of Vitamin C in the invention of claim 1, which must be taken into account. As set forth in the Manual of Patent Examining Procedure, "[a] prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention". See e.g., M.P.E.P. §2141.03 (Rev. 2 May 2004, p. 2100-127).

No teaching or suggestion has been cited with respect to the references taken as a whole as to why one of ordinary skill would disregard the teachings of the Brooks II reference to use its VITAZYME™ C form recommended therein. It is not at all apparent why one of ordinary skill would formulate the claimed a composition by accepting the teachings of Brooks II to use some of the VITAZYME™ vitamin forms therein, but then reject its teaching to use the other, the VITAZYME™

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C form. In claim 1, why use four polypeptide vitamin forms but not the fifth? The fact that applicant contrarily requires use of a different form of Vitamin C, and specifically does so in conjunction with the other VITAZYME<sup>TM</sup>, shows the non-obviousness of the claim.

Likewise, for the same reasons, with respect to claims 3, 4, and 5 no teaching or suggestion has been shown why, in view of the combination of references, one would use the VITAZYME<sup>TM</sup> D component recommended by Brooks II, then reject the VITAZYME<sup>TM</sup> C recommended by Brooks. "The mere fact that references can be combined or modified does not render the resultant combination obvious". M.P.E.P. §2143.01 (Rev. 2 May 2004, p. 2100-131). It is submitted that if the references were considered together, consideration of a Vitamin C form to be used with VITAZYME<sup>TM</sup> D would lead to VITAZYME<sup>TM</sup> C, and away from the claimed combination actually required by applicant.

With respect to dependent claims 15-18, there is also no showing why it would be obvious to use the particular compositions claimed in the preferred concentrations recited therein.

It is also noted that, in the prior Office Action response, further arguments were also submitted showing that the combination of VITAZYME<sup>TM</sup> D with ascorbylmethylsilanol pectinate would not be obvious. Those arguments additionally show the non-obviousness of the present invention, but it is respectfully submitted that they have not been addressed or given any weight. As of the time the invention was made, it appears that it was relatively uncommon for those in the art to use ascorbylmethylsilanol pectinate or VITAZYME<sup>TM</sup> D compared to other forms. Those of ordinary skill in the art desiring to provide a combination of Vitamin C and Vitamin D had more common forms of both available. With respect to all of the pending claims, Applicant departed from tradition, so to speak, and used two vitamin forms each of which was itself relatively uncommon, the two together being an

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even more unexpected combination. This is yet further evidence of non-obvious invention.

In view of the foregoing, reconsideration of the application and allowance of all of the pending claims is respectfully requested.

Dated: April 6, 2005

Respectfully submitted,



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